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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,903	03/14/2005	Fabio Perini	71699	9066
23872	7590	01/04/2008	EXAMINER	
MCGLEW & TUTTLE, PC			SELLS, JAMES D	
P.O. BOX 9227			ART UNIT	PAPER NUMBER
SCARBOROUGH STATION				1791
SCARBOROUGH, NY 10510-9227				
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			01/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/527,903	PERINI, FABIO	
	Examiner James Sells	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 December 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 March 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 6-10, 13, 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenschmidt (DE10043989) in view of Kubo et al (JP10249916).

Eisenschmidt discloses a pair of embossing rolls for making tissue articles. As shown in the figures, the rolls 1 and 2 comprise shafts 5 and 5" and engravings 3 and 6 which are used to emboss layers of tissue articles 9. These engravings have a helicoidal configuration with a preset pitch and direction in the manner claimed by the applicant.

However, Eisenschmidt does not disclose the elastic surface as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Kubo.

Kubo discloses a roller construction for pressing sheet materials. As shown in the figure, the roll 1 comprises shaft core 2, rubber layer 3, nickel tube 4a with hard chrome plated film 4b.

Such a construction improves deflectability, which imparts better embossing of the materials (see abstract). Therefore, it would have been obvious to one having ordinary skill in the art to employ an elastic material with a hard outer surface, as taught

by Kubo, in the device of Eisenschmidt in order to provide the predictable result of improving the deflectability to impart better embossing of the materials.

3. Claims 5, 11-12, 14-15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenschmidt in view of Kubo et al as described above in paragraph 2 in further view of McNeil et al (US Patent 6,030,690)

McNeil discloses an embossing apparatus comprising embossing rolls 30 and 32, which are preferably made of steel. See col. 8, lines 17-21. Such a material *inherently* has desirable physical and mechanical properties such as high strength and durability. For these reasons, it would have been obvious to one having ordinary skill in the art to employ steel in the outer surface of the embossing rolls of Eisenschmidt in view of Kubo as described above.

Regarding claims 12, 15 and 19, it is the examiner's position that adhesives are well known in the art for securely bonding or joining various materials together. Therefore it would have been obvious to one having ordinary skill in the art to employ an adhesive to connect the elastic material and the hard outer surface in order to provide the predictable result of more securely joining or bonding the materials together.

#### ***Response to Arguments***

4. Applicant's arguments filed 10/24/2007 have been fully considered but they are not persuasive.

Applicant argues Kubo et al. fails to address the problem of compressing paper webs to form a single continuous paper web without deforming or adversely altering the web. However, it is noted that the features upon which applicant relies (i.e., without deforming or adversely altering the web) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues Kubo et al. discloses that a roller having a resilient surface is crucial, but fails to suggest a hard outer surface supported by an elastic surface as claimed. The examiner does not agree. The abstract of Kubo et al specifically describes material 4b as a hard chrome plated film. Therefore applicant's argument is believed to be incorrect in this instance.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated above, The construction disclosed by Kubo et al improves deflectability, which imparts better embossing of the materials (see abstract). Therefore, it would have been obvious to one having ordinary skill in the art to employ an elastic material with a hard outer

surface, as taught by Kubo, in the device of Eisenschmidt in order to provide the predictable result of improving the deflectability to impart better embossing of the materials.

***Telephone/Fax***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is 571-272-1237. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

/James Sells/  
James Sells  
Primary Examiner  
Technology Center 1700